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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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JACKSON, JAKIEDA R

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,418

Applicant(s)

FEINBERG, PAUL

Examiner

Jakieda R Jackson

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. **Claims 35-43** are objected to because of the following informalities:
  - **Claims 39-43** refer to a method when depending on an apparatus claim and for examination purposes have been interpreted as apparatus claims.
  - **Claims 35-40** have typographical errors resulting in improper dependence or no antecedent basis. For examination purposes the following apparently intended interpretations have been made:
    - claim 35 depends on claim 32
    - claim 36 depends on claim 33
    - claim 37 depends on claim 32
    - claim 38 depends on claim 32
    - claim 39 depends on claim 32
    - claim 40 depends on claim 32

Appropriate correction required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-43** are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al (U.S. Patent No. 6,160,986), hereinafter referenced as Gabai.

Regarding **claim 1**, Gabai discloses an interactive toy, comprising the method of:

a) receiving at a remote location (remote server) user information (user input receiver) from a customizing device (toy) of a user (column 9, lines 47-51 and column 11, lines 8-17); and

b) transmitting to said customizing device customizing information for customizing a toy of the user and personalizing information selected based upon a personal profile (column 14, lines 52-56), said personalizing information being selected so that said toy appears familiar with the user after the user customizes said toy (column 2, lines 38-41 and column 10, lines 55-59).

Regarding **claim 2**, Gabai discloses the method wherein the user information comprises a request to receive customizing information (column 14, lines 47-52).

Regarding **claim 3**, Gabai discloses the method wherein the request is incorporated into the personal profile (column 14, lines 47-64).

Regarding **claim 4**, Gabai discloses the method wherein information concerning the customizing information sent to the customizing device is incorporated into the personal profile (column 14, lines 47-64).

Regarding **claim 5**, Gabai discloses the method further comprising the step of searching (queries) a customizing information database (column 38, lines 14-15) having multimedia content for customizing the toy (floppy disk or other media; column 39; lines 11-13).

Regarding **claim 6**, Gabai discloses the method further comprising selecting personalizing information comprising at least one voice clip (voice files), the at least one voice clip being selected based upon the personal profile so that the toy will appear familiar with the user (column 14, line 47-64).

Regarding **claim 7**, Gabai discloses the method wherein the personal profile comprises a record in a personal profile database consisting of information selected from the following: age, sex, movie preferences, television show preferences, cartoon character preferences, book preferences, color preferences, toy preferences, name preferences, address and billing information (age, gender and secret name; column 10, lines 44-59).

Regarding **claim 8**, Gabai discloses the method wherein the customizing information includes a voice clip (voice file) for producing a voice telling a story (Opening table; columns 13 and 14).

Regarding **claim 9**, Gabai discloses the method wherein said customizing information includes a voice clip for producing a voice telling a story and said personalizing information comprises a voice clip incorporated into the story (Story Menu Table; columns 15 and 16).

Regarding **claim 10**, Gabai discloses the method wherein said personalizing information comprises a voice clip for producing a voice commenting on personal information regarding the user as the story is told (feedback; column 4, line 30-33 and column 15 and 16; Story Menu Table).

Regarding **claim 11**, Gabai discloses the method further comprising the step of assembling the customizing information and personalizing information before the step of transmitting (request then transmit; column 14, lines 47-58).

Regarding **claim 12**, Gabai discloses the method wherein the customizing information comprises a plurality of audio files and the personalizing information comprises an audio file and the step of assembling includes inserting the file comprising personalizing information between predetermined files comprising customizing information (column 3, lines 5-13).

Regarding **claim 13**, Gabai discloses the method of customizing a toy, comprising:

a) transferring information from a customizing device to a toy (column 1, lines 61-65); and

b) storing said information in said toy, said information being selected so that said toy appears familiar with the user of the toy (column 10, lines 58-60).

Regarding **claim 14**, Gabai discloses the method further comprising connecting the customizing device to the toy (column 11, line 65 – column 12, line 6).

Regarding **claim 15**, Gabai discloses the method further comprising storing customizing information at the customizing device (column 11, lines 8-20).

Regarding **claim 16**, Gabai discloses the method wherein said customizing information comprises a voice clip and further comprising playing the voice clip through a speaker of a customizing device (column 3, line 66 – column 4, line 6).

Regarding **claim 17**, Gabai discloses the method wherein said voice clip is played while the customizing device is connected to the toy (column 3, lines 14-19).

Regarding **claim 18**, Gabai discloses the method wherein said customizing information comprises a voice clip and further comprising playing the voice clip through a speaker of said toy (column 2, lines 20-27 and column 3, line 66 – column 4, line 6).

Regarding **claim 19**, Gabai discloses the method further comprising selecting customizing information to be received at the customizing device (column 11, lines 8-20).

Regarding **claim 20**, Gabai discloses the method further comprising storing on the customizing device the customizing information selected (column 11, lines 8-20).

Regarding **claim 21**, Gabai discloses the method further comprising storing personalizing information at the customizing device with said customizing information (column 10, lines 44-51).

Regarding **claim 22**, Gabai discloses the method further comprising storing said personalizing information on a storage device of the toy (column 2, lines 38-41).

Regarding **claim 23**, Gabai discloses the apparatus for customizing a toy, comprising:

a) a computer having a first processor under control of programs and a first program executable by said first processor and adapted to receive requests from a user's customizing device at a remote location, and transmit to said customizing device customizing information for customizing the user's toy (column 11, lines 8-20);

b) said first program being adapted to select and transmit to said customizing device personalizing information selected based upon a personal profile so that said toy appears familiar with the user after the user customizes the toy (column 10, lines 58-60).

Regarding **claim 24**, Gabai discloses the apparatus of claim 23, wherein said first program is adapted to generate said personal profile based upon information submitted by the user (column 5, lines 38-41).

Regarding **claim 25**, Gabai discloses the apparatus further comprising a customizing device (remote server; column 11, lines 8-20).

Regarding **claim 26**, Gabai discloses the apparatus wherein the customizing device includes a second processor under control of programs (control device; figure 5, element 24) and a second program executable by said second processor (executable file) and adapted to receive said customizing information and personalizing information from said computer (column 23, lines 5-15).

Regarding **claim 27**, Gabai discloses the apparatus wherein said customizing device comprises a personal computer (figure 5, element 60).



Regarding **claim 28**, Gabai discloses the apparatus wherein said second processor is adapted to transmit information to the toy (column 11, lines 58-64).

Regarding **claim 29**, Gabai discloses the apparatus wherein said customizing information comprises a voice clip (column 14, lines 37-46).

Regarding **claim 30**, Gabai discloses the apparatus wherein said customizing device further comprises a speaker for playing said voice clip (column 3, line 66 – column 4, line 6).

Regarding **claim 31**, Gabai discloses the apparatus wherein said information transferred to said toy comprises at least some of the customizing information and personalizing information transferred to said customizing device (column 14, lines 47-58).

Regarding **claim 32**, Gabai discloses a customizing apparatus comprising:

a) a customizing device having a first processor under control of programs and a first storage device having a first program for requesting customizing information for customizing a toy and receiving said customizing information and personalizing information (column 14, lines 47-61); and

b) a toy adapted to receive information from said customizing device (column 11, lines 58-64);

c) said personalizing information being selected based upon a personal profile so that said toy appears familiar with said user after said toy is customized (column 11, lines 8-20).

Regarding **claim 33**, Gabai discloses the apparatus wherein said customizing information comprises a voice clip (voice file; column 14, lines 47-52).

Regarding **claim 34**, Gabai discloses the apparatus wherein said customizing device comprises a speaker for playing said voice clip (column 3, line – column 4, line 6).

Regarding **claim 35**, interpreted as depending on claim 32, Gabai discloses the apparatus wherein said toy comprises a socket (I/O port) for connecting said customizing device to said toy (column 38, lines 3-13).

Regarding **claim 36**, interpreted as depending on claim 33, Gabai discloses the apparatus wherein said toy comprises a speaker for playing said voice clip (column 2, lines 20-27).

Regarding **claim 37**, interpreted as depending on claim 32, Gabai discloses the apparatus wherein said first program comprises a program for receiving customizing information transmitted to said customizing device according to a wireless application protocol (column 11, lines 58-64).

Regarding **claim 38**, interpreted as depending on claim 32, Gabai discloses the apparatus wherein said first program comprises a program for receiving customizing information transmitted to said customizing device according to a hypertext transfer protocol (column 50, lines 24-28).

Regarding **claim 39**, interpreted as an apparatus and depending on claim 32, Gabai discloses the apparatus wherein said toy comprises a doll (column 1, lines 36-40 and column 23, lines 59-62).

Regarding **claim 40**, interpreted as an apparatus and depending on claim 32, Gabai discloses the apparatus wherein said toy comprises a game device having a second processor under control of programs and a second storage device having a second program for running software comprising a game column 4, lines 7-15).

Regarding **claim 41**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said customizing information comprises game software to be transferred to said game device (column 14, lines 58-61).

Regarding **claim 42**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said personalizing information (column 4, lines 55-63) comprises an audio clip selected so that said game device appears familiar with the user (column 10, lines 58-60).

Regarding **claim 43**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said profile includes preferences concerning game content (column 11, lines 47-57).

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

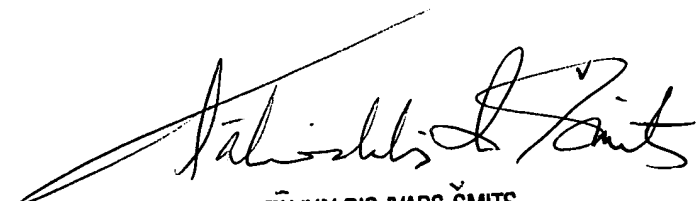
- Uppaluru (U.S. Patent No. 6,400,806) discloses a system and method for providing and using universally accessible voice and speech data files.
- Kochian (U.S. Patent No. 6,278,976) discloses a system for delivery of audio recordings.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R Jackson whose telephone number is 703.305.5593. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talivaldis I. Smits can be reached on 703. 306-3011. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.4700.

JRJ  
December 30, 2003



TĀLIVALDIS IVARS ŠMITS  
PRIMARY EXAMINER